

### **REMARKS**

Applicant acknowledges and appreciates the Examiner's allowance of claims 1-10 and 27. Applicant respectfully requests that the Examiner enter this amendment including newly added claims 28-36. The newly added claims all depend from allowed claim 27 and as such are also allowable.

Applicant believes the additional claims are necessary to properly protect the invention and that the entry of this amendment will not require a substantial amount of additional work on the part of the Examiner. Because the added claims all depend from an allowed claim, no additional search or examination will be required. Applicant failed to provide these dependent claims with the last response because it was unclear if the Examiner would examine independent claim 27.

Applicant understands that the Examiner can elect to not enter the present amendment where an additional search is required, more than a cursory review of the record is required, or the amendment requires materially added work on the part of the Examiner. *See MPEP 714.16*. However, Applicant notes that where only dependent claims are added, "some of the usual reasons for nonentry are less likely to apply although questions of new matter, sufficiency of disclosure, or undue multiplicity of claims could arise." *MPEP 714.16*.

### **CONCLUSION**

In light of the foregoing, Applicant respectfully requests entry of the amendment under 37 C.F.R. 1.312 and allowance of claims 1-10 and 27-36.

The undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'TJ Otterlee', with a stylized flourish at the end.

Thomas J. Otterlee  
Reg. No. 48,652

Docket No.: 043210-1543-00  
Michael Best & Friedrich LLP  
100 East Wisconsin Avenue  
Milwaukee, Wisconsin 53202-4108

(414) 271-6560



United States Patent and Trademark Office

PATENTS

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

Patents &gt; 714.16 Amendment After Notice of Allowance, 37 CFR 1.312 [R-2] - 700 Examination of Applications

[Go to MPEP - Table of Contents](#)[browse before](#)

## 714.16 Amendment After Notice of Allowance, 37 CFR 1.312 [R-2] - 700 Examination of Applications

### 714.16 Amendment After Notice of Allowance, 37 CFR 1.312 [R-2]

\*\*&gt;

#### 37 CFR 1.312 Amendments after allowance.

No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Director, without withdrawing the application from issue.<

---

The amendment of an application by applicant after allowance falls within the guidelines of **37 CFR 1.312**. Further, the amendment of an application broadly encompasses any change in the file record of the application. Accordingly, the following are examples of "amendments" by applicant after allowance which must comply with **37 CFR 1.312**:

- (A) an amendment to the specification,
- (B) a change in the drawings,
- (C) an amendment to the claims,
- (D) a change in the inventorship,
- (E) the submission of prior art, etc.

Finally, it is pointed out that an amendment under **37 CFR 1.312** must be filed on or before the date the issue fee is paid>, except where the amendment is required by the Office of Patent Publication, see MPEP § 714.16(d), subsection III. An amendment under 37 CFR 1.312 must comply with the provisions of 37 CFR 1.121<.

The \*>Director< has delegated the approval of recommendations under **37 CFR 1.312** to the supervisory patent examiners.

With the exception of a supplemental oath or declaration submitted in a reissue, a supplemental oath or declaration is not treated as an amendment under **37 CFR 1.312**. See **MPEP § 603.01**. A supplemental reissue oath or declaration is treated as an amendment under **37 CFR 1.312** because the correction of the patent which it provides is an amendment of the patent, even though no amendment is physically entered into the specification or claim(s). Thus, for a reissue oath or declaration submitted after allowance to be entered, the reissue applicant must comply with **37 CFR 1.312** in the manner set forth in this section.

After the Notice of Allowance has been mailed, the application is technically no longer under the jurisdiction of the primary examiner. He or she can, however, make examiner's amendments (see **MPEP § 1302.04**) and has authority to enter amendments submitted after Notice of Allowance of an application which embody merely the correction of formal matters in the specification or drawing, or formal matters in a claim without changing the scope thereof, or the cancellation of claims from the application, without forwarding to the supervisory patent examiner for approval.

Amendments other than those which merely embody the correction of formal matters without changing the scope of the claims require approval by the supervisory patent examiner. The Technology Center (TC) Director establishes TC policy with respect to the treatment of amendments directed to trivial informalities which seldom affect significantly the vital formal requirements of any patent, namely, (A) that its disclosure be adequately clear, and (B) that any invention present be defined with sufficient clarity to form an adequate basis for an enforceable contract.

Consideration of an amendment under **37 CFR 1.312** cannot be demanded as a matter of right. Prosecution of an application should be conducted before, and thus be complete *including editorial revision of the specification and claims* at the time of the Notice of Allowance. However, where amendments of the type noted are shown (A) to be needed for proper disclosure or protection of the invention, and (B) to require no substantial amount of additional work on the part of the Office, they may be considered and, if proper, entry may be recommended by the primary examiner.

★★

The requirements of **37 CFR 1.111(c)** (~~MPEP § 714.02~~) with respect to pointing out the patentable novelty of any claim sought to be added or amended, apply in the case of an amendment under **37 CFR 1.312**, as in ordinary amendments. See **MPEP § 713.04** and **§ 713.10** regarding interviews. As to amendments affecting the disclosure, the scope of any claim, or that add a claim, the remarks accompanying the amendment must fully and clearly state the reasons on which reliance is placed to show:

(A) why the amendment is needed;

(B) why the proposed amended or new claims require no additional search or examination;

(C) why the claims are patentable; and

(D) why they were not presented earlier.

> I. < NOT TO BE USED FOR CONTINUED PROSECUTION

**37 CFR 1.312** was never intended to provide a way for the continued prosecution of an application after it has been passed for issue. When the recommendation is against entry, a detailed statement of reasons is not necessary in support of such recommendation. The simple statement that the proposed claim is not obviously allowable and briefly the reason why is usually adequate. Where appropriate, any one of the following reasons is considered sufficient:

- (A) an additional search is required;
- (B) more than a cursory review of the record is necessary; or
- (C) the amendment would involve materially added work on the part of the Office, e.g., checking excessive editorial changes in the specification or claims.

Where claims added by amendment under **37 CFR 1.312** are all of the form of dependent claims, some of the usual reasons for nonentry are less likely to apply although questions of new matter, sufficiency of disclosure, or undue multiplicity of claims could arise.

See MPEP § 607 and § 714.16(c) for additional fee requirements.

## > II. < AMENDMENTS FILED AFTER PAYMENT OF ISSUE FEE

No amendments should be filed after the date the issue fee has been paid.

### ¶ 13.10 Amendment Filed After the Payment of Issue Fee, Not Entered

Applicant's amendment filed on [1] will not be entered because the amendment was filed after the issue fee was paid. 37 CFR 1.312 no longer permits filing an amendment after the date the issue fee has been paid.

#### Examiner Note

1. Use this paragraph with form PTOL-90 or PTO-90C.
2. In bracket 1, insert the date of the amendment.

browse after

**KEY:** =online business system =fees =forms =help =laws/regulations =definition (glossary)

*The Inventors Assistance Center is available to help you on patent matters. Send questions about USPTO programs and services to the USPTO Contact Center (UCC). You can suggest USPTO webpages or material you would like featured on this section by E-mail to the [webmaster@uspto.gov](mailto:webmaster@uspto.gov). While we cannot promise to accommodate all requests, your suggestions will be considered and may lead to other improvements on the website.*